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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,280	01/30/2002	Terumi Matsuda	2091-0249P	2656

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EXAMINER
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THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/058,280

Applicant(s)

MATSUDA ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 and 103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

Applicants' "Amendment Under 37 CFR § 1.111" filed on September 9, 2005 has been considered with the following effect.

Applicants' response by virtue of amendment to claim 20 has not overcome the Examiner's rejection under 35 USC § 101 and 35 USC § 112, second paragraph.

Applicants' response by virtue of amendment to claim 21 has overcome the Examiner's rejection under 35 USC § 101 and 35 USC § 112, second paragraph.

Claims 1, 2, 5, 10, 13-14, and 17-21 are amended. New claim 22 is added. Claims 1-22 remain pending in this application and an action on the merits follows.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 is unclear because of the combining of two different statutory classes of invention in a single claim. The preamble recites both a method and a program. If Applicants decide to recite the claim as a program, the claim would be rejected under 35 USC 101 because it fails to recite computer executable instructions in a computer readable medium. The claims are directed to a program. The claim fails to recite a positive functional interrelationship between the medium and

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the activities recited. Please refer to MPEP 2106. For examination purposes, the Examiner will interpret the claim to recite a program.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,812,962 to Fredlund et al.**

Regarding claims 20-21, Fredlund discloses a program and a computer-readable medium comprising: generating order information regarding image data to be printed, to be printed, the order information includes at least the image data to be printed, information indicating a print size of the image data, and information indicating a print quantity of the image data (col. 5, lines 7-9; col. 5, lines 21-26; col. 9, lines 3-6); reading access information indicating at least a specific photograph processing agency available to access and an order reception server installed in the specific photographic processing agency and utilized for directly accessing the order reception server (col. 6, lines 27-39; col. 8, lines 41-49); and transferring the ordering information to the order reception server installed in the specific photograph processing agency by directly accessing the order reception server according to the access information (col. 6, lines

27-39; col. 8, lines 41-49; col. 8, line 65 – col. 9, line 3; col. 9, lines 40-45); and access information area (col. 6, lines 27-39; col. 8, lines 41-49).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 6-13, 15-18 and 103 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,636,837 to Nardozzi et al in view of U.S. Patent No. 6,321,231 to Jebens et al.**

Regarding claims 1, 13, 17, and 103, Nardozzi discloses a print order system and a program comprising: order reception servers (computer 39) enabling reception of order information regarding image data via a network (the computer ...are received communicates with the remote collection database systems so as to obtain an order information; col. 3, lines 60-63) and installed respectively in a photograph processing agencies (photo finishing lab 39) each having a photographic printer for printing the image (col. 3, lines 53-64; col. 6, lines 19-23; col. 10, lines 45-67); and an order terminal (ordering apparatus; remote kiosks 10) connected to the order reception servers via the network (Figure 2), the order terminal generating the order information and placing an order for a print of the image data by transferring the order information to a corresponding one of the order reception servers installed in a photograph processing

agencies (indicia identifies the photofinishing lab which the order is to be sent for completion, col. 7, lines 39-40) after directly accessing the order reception server of the photographic processing agency (col. 3, lines 24-34; col. 3, lines 53-64); and a photographic printer for outputting a print of image data (col. 6, lines 19-27).

However, Nardozzi does not explicitly disclose plurality of photographic processing agencies; the order terminal connected to each of the order reception servers in the plurality of photograph processing agencies; wherein the order receptions server transfers the order information to another order reception server in another photographic agency; and the order terminal is a personal computer connectable to the network and owned by the user for placing the print. Nardozzi discloses retail establishment which sends the photofinishing orders to more than one central photofinishing lab (col. 2, lines 18-20). Nardozzi further discloses a photofinishing 38 includes a computer 39 (col. 6, lines 33-34) and indicia which identifies the photofinishing lab (col. 7, lines 39-41).

Jebens, on the other hand, teaches the plurality of photograph processing agencies (jobber/supplier) (col. 7, lines 24-26; col. 22, lines 24-35); the order terminal connected to each of the order reception servers in the plurality of photograph processing agencies (col. 22, lines 24-25; col. 22, lines 58-63; col. 23, lines 8-18); and wherein the order receptions server transfers the order information to another order reception server in another photographic agency (col. 2, lines 26-29); and the order terminal is a personal computer connectable to the network and owned by the user for placing the print (col. 6, lines 52-55; col. 6, lines 61-65; col. 7, lines 22-26).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made modify the system of Nardozzi to include the plurality of photographic processing agencies; the order terminal connected to each of the order reception servers in the plurality of photograph processing agencies; wherein the order receptions server transfers the order information to another order reception server in another photographic agency; and the order terminal is a personal computer connectable to the network and owned by the user for placing the print, as taught by Jebens, in order to provide a selection for the user (Jebens, col. 22, lines 24-28).

Regarding claims 2 and 18, Nardozzi discloses the order information is generated and transferred by a program installed in the order terminal (col. 2, lines 54-61).

Regarding claims 6-12, and 15-16, Nardozzi discloses wherein the access information used for accessing the order reception server of the agency is printed on a printing medium and the order terminal reads the access information from the printing medium (Figure 4a; col. 7, lines 30-41; col. 7, lines 57-65); wherein the access information is obtained a predetermine Web server and the order terminal access the order reception server (Figure 5b and Figure 5c; col. 5, lines 24-31); wherein information used for accessing the order reception server of the specific agency and obtains photographic processing agency information regarding the specific photograph processing agency (Figures 5a-5g); a charge of the print (col. 5, lines 36-41) and the item of delivery of the print (Figure 4a); notifies the order terminal of status of printing based on the order information (col. 3, lines 50-64); attachment information output

means for printing attachment information to be attached to the print (col. 9, lines 18-52); and access information for directly accessing an order reception server installed in a photograph processing agency (col. 10, lines 45-67).

**Claims 3-5, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nardozzi and Jebens as applied to claims 1, 13, and 17 above, and further in view of U.S. Patent No. 6,812,962 to Fredlund et al.** Nardozzi and Jebens substantially disclose the claimed invention, however, the combination does not disclose the recording medium recorded with access information. The combination does disclose a computer software program for monitoring the sales of the photofinishing goods and/or services (Nardozzi, col. 2, lines 57-59).

Fredlund, on the other hand, teaches the recording medium recorded with access information (col. 4, lines 50-62; col. 5, lines 15-20).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination of Nardozzi and Jebens, to include the recording medium recorded with access information, as taught by Fredlund, in order for automatically forwarding image data which is simple in construction and easy to use (Fredlund, col. 2, lines 18-20).

### ***Response to Arguments***

Applicant's arguments filed on September 9, 2005 have been fully considered but they are not persuasive.

Applicants remark that "Jebens does not teach or suggest the order reception servers...installed respectively in a plurality of photograph processing agencies each



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having a photographic printer for printing the image data". "Therefore, it is not proper to combine the server of Nardozzi et al. with the jobbers/suppliers 16 of Jebens et al."

The Examiner notes that Nardozzi was cited for disclosing an order reception servers enabling reception of order information regarding image data via a network and installed in a photograph processing agency. The computer 39 of Nardozzi is considered the order reception server. The computer of Nardozzi communicates with the remote collection database systems so as to obtain order information (col. 3, lines 60-63). The computer is at the photofinishing lab 38 (Figure 2). The Examiner then turns to Jebens to disclose the plurality of photographic processing agencies and the order terminal connected to each of the order reception servers in the plurality of photograph processing agencies. Jebens discloses a jobber/supplier which is considered the plurality of photograph processing agency. The jobbers/suppliers are agencies such as printers (col. 6, lines 60-61). They are provided with a workstation or personal computer and a modem (col. 7, lines 23-25). Jebens discloses a user placing a work order by filling in the form with a short description and instruction for the receiver (col. 21, lines 61-67). After the work order is complete, the user will select the "Send order" option to display the send screen. The user can then select a destination from a list of jobbers/suppliers obtained by clicking the "Supplier" icon. (Col. 22, lines 24-28) The work order is transmitted to the jobber/supplier where the jobber/supplier access the order and is stored in the jobber/supplier's local computer (col. 23, lines 9-18).

Applicants remark that "Nardozzi et al. fails to suggest the subject matter of dependent claims 22).

Examiner directs Applicants attention to the Office Action above.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mtot  
November 27, 2005



**STEVE B. MCALLISTER**  
**PRIMARY EXAMINER**